

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2214224
BY YAMANOUCHI EUROPE B.V.
TO REGISTER A TRADE MARK
SALMAX
IN CLASSES 5 & 10

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50993
BY ALMIRALL-PRODESFARMA S.A.

BACKGROUND

1) On 13 November 1999, Yamanouchi Europe B.V. of Elisabethhof 19, 2350 AC Leiderdorp, The Netherlands, applied under the Trade Marks Act 1994 for registration of the mark SALMAX in respect of the following goods:

In Class 5: "Pharmaceutical preparations for human use, all for the treatment of respiratory diseases."

In Class 10: "Inhalers."

2) On the 19 May 2000 Almirall-Prodesfarma S.A. of Ronda General Mitre 151, 080222 Barcelona, Spain filed notice of opposition, subsequently amended, to the application. The amended grounds of opposition are in summary:

a) The opponent is the proprietor of Community Trade Mark Registration No. 387175 ALMAX applied for on 12 November 1996, registered on 7 December 1999 for "A special pharmaceutical product for neutralising gastric hyperacidity" in Class 5. The registration was assigned to the opponent by Fordonal S.A..

b) The opposition concerns the Class 5 goods of the applicant only. The mark in suit is confusingly similar to the opponent's trade mark and is to be registered for similar goods in Class 5. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard.

OPPONENT'S EVIDENCE

5) The opponent filed two witness statements. The first, dated 20 March 2001, is by Manuel Bellostas Sanchez and Manuel Lopez Gonzalez the legal representatives of the opponent company. They state that they have "full and free access" to the company records.

6) Messrs Sanchez and Gonzalez state that the opponent company was founded in 1943 and manufactures and sells a wide range of pharmaceutical products. They state that it is the largest Spanish pharmaceutical company which has subsidiaries and sales offices worldwide. The opponent uses its mark ALMAX on an anti-infective product. At exhibit 2 a leaflet, in Spanish, showing the opponent's mark is provided. The translation states that the product is an antacid which works within one minute. It also states that "more than 80 million treatments have made Almax Forte the most widely prescribed antacid".

7) The mark was first used in 1984 by Fordonal S.L. before being transferred to the opponent. At exhibit 3 is a copy of the notarial testimony relating to the transaction together with a verified translation. The exhibit states that all the trade marks, commercial names, Patents and assets and liabilities pertaining to Fordonal were transferred to the opponent company on 9 September 1999. A copy of the Community Trade Mark registration under the name Fordonal is provided at exhibit 8. At exhibit 9 is said to be confirmation from OHIM that the registration had been transferred to the opponent. However, the document is in Spanish.

8) It is claimed that sales in Spain under the mark ALMAX have averaged 32 million Euros per annum for the years 1998-2000 inclusive. The product is for neutralising gastric hyperacidity. At exhibit 10 is a sample of the packaging for the tablet form of the product. Although in Spanish it clearly shows the opponent's trade mark. The product is said to be available over the counter for "664ptas, retail price, per unit".

9) It is claimed that the product has acquired a reputation in Spain. It is pointed out that the applicant's mark contains the whole of the opponent's trade mark. At exhibit 12 a printout of all current and lapsed registrations in Class 5 on the UK Register which include the word "MAX" is provided. It is stated that although there are a large number only one contains the word ALMAX. It is claimed that the mark in suit is confusingly similar to the opponent's mark and that this could be dangerous to the public as pharmaceutical products are involved.

10) The second witness statement, dated 17 May 2001, is by Nicholas David Baker, the opponent's Trade Mark Attorney. His statement has attached to it translations of three of the documents included in the statement of Messrs Sanchez and Gonzalez. These have been incorporated into the summary of that statement in paragraphs 5-9 above.

APPLICANT'S EVIDENCE

11) The applicant filed a statement, dated 23 January 2002, by Helene Michelle Whelbourn the applicant's Trade Mark Attorney. Ms Whelbourn states that although the mark in suit "wholly contains the mark of the opponent, the first letter shapes the mark. It is unlikely to be slurred when the mark is spoke nor omitted when writing, as ending often can be. The additional letter at the beginning of the mark significantly alters the visual look and the sound of the mark".

12) Ms Whelbourn claims that the specifications are not identical. The opponent's mark is for an antacid whilst the applicant's mark is for the treatment of respiratory orders. She claims that "the purchaser, vendor, pharmacist or prescribing general practitioner would take greater care to ensure the correct product is acquired and used by the patient than would be the case with many

other products.” Ms Whelbourne also provides a schedule of marks containing the word MAX on the UK trade marks register. However, in the absence of evidence of use of any of these marks I do not find this schedule of any assistance.

OPPONENT’S EVIDENCE IN REPLY

13) The opponent filed a second statement by Nicholas David Baker, dated 10 June 2002. He comments that the addition of a single letter to the opponent’s mark, even when the additional letter is at the start of the mark, is insufficient to distinguish that mark from the opponent’s mark. He claims that when the additional letter is “soft or sibilant, as is the case here, its effect upon the pronunciation of the mark is negligible. Even visually, the mere addition of one letter at the beginning of a registered five letter trade mark should not be regarded as sufficient to change the identity and appearance of the mark”.

14) Mr Baker points out that the opponent’s mark is a “distinctive manufactured word that will not be found in any dictionaries”. He therefore asserts that it is entitled to a wider degree of protection than non distinctive words or devices. He repeats the charge that the marks are similar both visually and phonetically. They are both for pharmaceutical products that are “likely to be prescribed, sold or otherwise made available to the public through similar trade channels”.

DECISION

15) The only ground of opposition is under Section 5(2)(b) of the Act which states:

“5.-(2) A trade mark shall not be registered if because -

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

16) An earlier trade mark is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

17) The opponent’s Community Trade Mark registration No. 387175 is plainly an “earlier trade mark”.

18) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133

paragraph 29.

19) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

20) The opposition is in relation to the applicant's goods in Class 5 only. The specifications of the two parties are as follows:

Applicant's Specification	Opponent's Specification
Pharmaceutical preparations for human use, all for the treatment of respiratory diseases.	A special pharmaceutical product for neutralising gastric hyperacidity

21) In order to assess the similarity of the goods and services, I note the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods;
- b) the users of the respective goods;
- c) the physical nature of the goods;
- d) the trade channels through which the goods reach the market;
- e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- f) the extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

22) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account.

Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

23) Clearly the products of the two parties are designed to treat different ailments, the applicant’s specification is for respiratory diseases whilst the opponent’s specification is for treating gastric hyperacidity. It is possible that a user may suffer from both ailments, whether at the same or different times. There is no evidence of the exact physical nature of the goods, although they are both pharmaceuticals. As neither is restricted to prescription then it must be assumed that both would be available over the counter in any pharmacy. Although in the same Class the goods are not competitive or complementary. Therefore, there is some similarity between the goods, but not a very high degree of similarity.

24) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

25) Visually the applicant’s mark is identical to the opponent’s mark apart from the addition of an “S” at the beginning. However, it is accepted that particularly in short trade marks differences in the initial letter of a word are very significant.

26) Phonetically the marks have common endings. Both are two syllable words “SAL - MAX” and “AL-MAX”. The opponent contends that the letter “S” at the start of the applicant’s mark is “soft or sibilant” and that its effect on the pronunciation of the mark is negligible. Whilst I accept that the presence of the letter “S” does indeed produce a hissing or sibilant sound I cannot concur that its effect on the pronunciation is negligible. To my mind the letter “S” produces a distinct sound and is one which is usually pronounced in a marked manner when placed at the beginning of a word.

27) Conceptually, neither mark conveys any meaning, both being made up words.

28) Items of medication are, I would suggest, chosen with some care. The average consumer will be seeking a product to alleviate a particular medical condition. If the product is prescribed then the chances of confusion are less. However, the goods may be purchased over the counter and the pharmacists advice may not be sought.

29) Ordinarily I would also consider whether the opponent’s mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence of use in the UK has been filed. In such circumstances the opponent’s marks cannot be regarded as enjoying an above average reputation at the relevant date, but it is an inherently strong mark. I must also take into account the dictum of imperfect recollection.

30) With all of this in mind I come to the conclusion that when all factors are considered, that there was no likelihood of confusion at 13 November 1999. Consequently, the opposition under Section 5(2)(b) fails.

31) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £535. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of November 2002

George W Salthouse
For the Registrar
The Comptroller General